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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/814,403	03/22/2001	Yihua Chang	11302-1190 (44040-256047)	3830
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JOHN S. PRATT  
KILPATRICK STOCKTON LLP (KIMBERLY CLARK)  
1100 PEACHTREE STREET  
SUITE 2800  
ATLANTA, GA 30309

EXAMINER
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WILSON, DONALD R

ART UNIT	PAPER NUMBER
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1713

07

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 09/814,403	Applicant(s) CHANG ET AL.	
	Examiner Donald R Wilson	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 21 April 2003.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-22 is/are pending in the application.
  - 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-5 and 10-22 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All    b)  Some \*    c)  None of:
    - 1.  Certified copies of the priority documents have been received.
    - 2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4)  Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other:

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**DETAILED ACTION**

**Response to Amendment**

1. Applicant's amendment filed 4/21/03, has been fully considered with the following results.
2. The amendment overcomes the rejections under 35 U.S.C. § 112, first paragraph, and the rejections are withdrawn.
3. The amendment overcomes the rejection under 35 U.S.C. § 112, second paragraph, and the rejection is withdrawn, except in regards to the indefiniteness of claims reciting "hard or soft water" for which the rejection is maintained as is discussed below.
4. The amendment is not deemed to be persuasive in overcoming the prior art rejection which is maintained for reasons discussed below.

**Previously Cited Statutes**

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

**Duplicate Claim Warning**

6. **Applicant is advised that should Claim 19 be found allowable, Claim 21 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.** When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

**Objection to New Matter**

7. **The amendment filed 4/21/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure.** 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

There appears to be no basis in the specification as filed for the cationic polymer comprising cationic monomer units, water insoluble, hydrophobic monomeric units, hydrophilic monomeric units, and water-soluble nonionic monomeric units, as is currently recited in Claim 13. The

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Examiner acknowledges a basis for cationic polymers comprising cationic monomer units, water insoluble, hydrophobic monomeric units, and hydrophilic monomeric units, or water-soluble nonionic monomeric units

8. Applicant is required to cancel the new matter in the reply to this Office Action, or to specifically point to a basis for the new matter in the application as filed.

***Claim Rejections - 35 USC § 112, First Paragraph***

9. ***Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.*** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter in question is the new matter just discussed.

***Claim Rejections - 35 USC § 112, Second Paragraph***

10. ***Claims 4-5, 11, 13-17 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

11. The language of Claim 4 is indefinite because the claim lacks antecedent basis for "the non-cross-linked co-binder polymer" (line 4). Further, if the co-binder polymer is limited to a non-cross-linked co-binder, the claim is then a duplicate of Claim 5, which will also be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

12. The language of Claims 4, 5 and 22 are indefinite because the metes and bounds of hard or soft water cannot be determined. The basis of this rejection was previously stated in Detailed Acton § 14 of the previous Office Action. Applicant has traversed the rejection arguing that the claims are not indefinite when construed in accordance with the specification. Applicant attempts to support this allegation by pointing to four places where the hard or soft water used has up to 200 ppm calcium and magnesium ions. None of the places pointed to define the terminology "hard and soft water" means having up to 200 ppm calcium and magnesium ions. Therefore, it remains that read in light of the specification, the metes

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and bounds of soft or hard water cannot be determined. If applicants intent is to claim dispersibility in water having up to 200 ppm calcium and magnesium, then an amendment to that effect as opposed to dispersibility in hard or soft water will overcome the rejection.

13. Claims 11 and 13-17 are indefinite because "hydrophilic" is a relative term, the metes and bounds cannot be determined.

***Claim Rejections - 35 USC § 102(b)/§ 103(a)***

14. ***Claims 1-5 and 10-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Larson '007, or Larson '841.*** The basis of this rejection was stated in Detailed Action § 18-19 of the previous Office Action.

15. Applicant traverses the rejection on the basis that Claim 4 wasn't previously rejected and that Claims 1-3 and 5 have been amended to a format similar to original Claim 4 and are therefore allowable. This is not deemed to be persuasive because the substantial difference between unamended Claims 1-3 and 5 versus Claim 4 was the previous recitation of the polymer formulation being soluble in water as opposed to being dispersible. This difference was also clearly pointed out in the rejection under 35 U.S.C. § 112, first paragraph, reciting non-enablement for unamended Claim 4. In regards to the limitations of claims now reciting that the monomeric units of the cationic polymer comprise cationic monomers, water insoluble, hydrophobic monomers, and/or hydrophilic or water soluble monomers, this is clearly within the teachings of the references. As was previously pointed out, "[s]uitable charge directors are acrylate copolymers of 2-trialkylammoniummethyl (meth)acrylates and 2-trimethylammoniummethyl methacrylate chloride/ethylhexyl methacrylate copolymers are specifically disclosed (col. 8, lines 12-18, col. 7, lines 47-53, respectively)." As can be seen from the formulas in Larson'007 and '841 (col. 7, line 43, to col. 8, line 11, and col. 7, lines 3-46, respectively), the charge director cationic polymers can also contain a vinylpyridinium salt monomeric unit, which would qualify both as a hydrophilic or water soluble monomer.

***Art of Interest/Technological Background***

16. As previously noted Gray, EP'284, and WO'698, could be used in the future to reject non-elected species of the invention.

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**Information Disclosure Statement**

17. Applicant is thanked for specifically pointing to Brodynan (U.S. Patent 4,356,229) and Bjorkquist (U.S. Patent 6,127,593) for the Examiner's consideration.

18. The information disclosure statements (IDS's) filed 2/20/03, 2/25/03 and 3/18/03 fail to comply with 37 CFR 1.97(c) because: (i) they lack the fee set forth in 37 CFR 1.17(p); and (ii) the statements as specified in 37 CFR 1.97(e) are not sustainable based upon the evidence of record. The IDS's have been placed in the application file, but the information referred to therein has not been considered. In regards applicant's statements, the counterpart application of the instant application is PCT/US02/04904, not PCT/US02/04942 (counterpart of US applicant Serial No. 09/815251), PCT/US02/04943 (counterpart of US applicant Serial No. 09/815261), nor PCT/US02/04939 (counterpart of US applicant Serial No. 09/815243).

**Action Is Final**

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. This application contains Claims 6-9 drawn to an invention nonelected with traverse in Paper No.

11. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

**Future Correspondence**

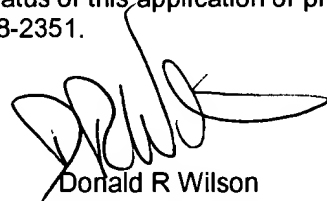
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311

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for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

A handwritten signature in black ink, appearing to read 'DR Wilson', with a long horizontal stroke extending to the right.

Donald R Wilson  
Primary Examiner  
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